

reading of the bar-coded indicium by the first bar-code reader. The "third paper path" leads to a "second bar-code reader". If the reading of the indicium by the "second bar-code" reader is successful, the mail pieces go to a "fourth paper path", and if unsuccessful, the mail pieces go to a "fifth paper path." None of these features are disclosed or suggested by Gilham.

Gilham does not disclose or suggest a "first bar code reader" or a "second bar code reader" in its system. Gilham only discloses feeding mail items through a reading means and scanning indicia on the mail items. (Col. 4, lines 57-60). Gilham does not disclose or suggest collating a mail piece in a second paper path in the event of a successful reading and collating a mail piece in a third paper path in the event of an unsuccessful reading, the "third paper path leading to said second bar-code reader", as recited by Applicant in claim 1. Rather, Gilham deals with encrypting authentication data printed in the indicia using an algorithm and a secret key. (Col. 4, lines 33-39.) In Gilham, if the data is authenticated and genuine it is accepted. However, if the data does not correspond (i.e., not authenticated and not genuine), the computer rejects the mail item and "checking authentication of the indicium on that mail item ends (END 58)." This is quite different from Applicant's invention, since if, in Applicant's invention, the reading is unsuccessful, the mail piece is collated to the "third paper path leading to said second bar-code reader." Thus, there are quite obvious gaps between what is claimed by Applicant and what is disclosed by Gilham, which negate any determination of obviousness under 35 U.S.C. §103(a). The section of Gilham cited by the Examiner does not disclose or suggest any of these claimed features. Under 35 U.S.C. §103(a), each element of Applicant's invention must be disclosed or suggested by the

references either alone or in combination. Since Gilham lacks certain features and element as claimed by Applicant, claim 1 is not disclosed or suggested by Gilham.

Pintsov does not overcome the deficiencies of Gilham. Pintsov is directed to creating a mailing list including destination addresses for mail pieces to be submitted to a carrier service for delivery. (Col. 3, lines 39-51). Pintsov does not disclose or suggest first and second bar code readers or collating a mail piece in a second paper path in the event of a successful reading and collating a mail piece in a third paper path in the event of an unsuccessful reading, the "third paper path leading to said second bar-code reader", as is recited by Applicant in claim 1. Rather, Pintsov is only concerned with the assignment of unique identification numbers to mailpieces by the carrier and is not relevant to the inexpensive authentication of mailpieces as in Applicant's invention. The section of Pintsov cited by the Examiner does not disclose or suggest any of the features of Applicant's invention as recited in claim 1, or any subsequent claims. Thus, neither Gilham nor Pintsov, either alone or in combination, disclose or suggest Applicant's invention as claimed. In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each element of Applicant's invention as claimed must be disclosed or suggested by the proposed combination of references. See M.P.E.P. §2142. Since in this case each element clearly is not disclosed or suggested, the requirements of 35 U.S.C. §103(a) have not been met. Therefore Applicant's invention according to claim 1 is patentable. Claims 2-5 depend from claim 1 and should be allowable at least in view of the dependencies.

Furthermore, it is respectfully submitted that there is no suggestion or motivation to combine the references in the manner proposed by the Examiner. In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in art, to modify the reference or to combine reference teachings. Gilham is directed to encrypting authentication data printed in the indicia by using an algorithm and secret key. (Col. 4, lines 33-39). Pintsov is directed to the assignment of unique identification numbers to mail pieces by the carrier and creating a mail list including destination addresses from mail pieces to be submitted to a carrier service for delivery. (Col. 3, lines 39-51). There is no motivation or suggestion in either Gilham or Pintsov to combine the references in order to obtain a system for authenticating mail pieces with bar code indicia as is claimed by applicant. Therefore, a *prima facie* case of obviousness has not been established and claims 1-5 should be patentable.

Furthermore, with respect to claims 2-5, Pintsov does not disclose or suggest a second bar code reader. Although the Examiner refers to Col. 3, lines 10-67, there is no disclosure or suggestion of a second bar code reader. Thus, the elements of claims 2-5 are not disclosed or suggested by the combination of Gilham and Pintsov.

2. Claims 6-19 are not unpatentable over Gilham in view of Pintsov. Claim 6 recites automatically collating the mail piece to a second paper path to a second bar code reader in the event of an unsuccessful reading of the indicium by the first bar code reader. As noted above, Gilham does not disclose or suggest

collating a mail piece to a second paper path to a second bar code reader in the event of an unsuccessful reading of an indicium by the first bar code reader. As also described above, Pintsov does not disclose or suggest a second bar code reader. Gilham, in Col. 2, lines 1-36, merely discloses methods and apparatus for authentication of postal indicia by reading a secret key that is modified in dependence upon postage data to be printed and a postage indicium. Gilham does not disclose or suggest collating a mail piece to a second paper path to a second bar code reader in an event of an unsuccessful reading of the indicium by the first bar code reader. Thus, claim 6 is not disclosed or suggested by the combination of Gilham and Pintsov. Claims 7-19 depend from claim 6, and these claims should also be allowable in view of at least the dependencies.

3. Claims 20-23 are not unpatentable over Gilham in view of Pintsov. Claim 20 recites first, second and third bar code readers and that the system is disposed to collate mail pieces in a third paper path in the event of an unsuccessful reading of the reader of the bar coded indicium by the first bar code reader. The third paper path leads to the third bar code reader. As noted previously, neither Gilham nor Pintsov disclose first and second bar code readers, or that the system collates a mail piece bearing an unsuccessfully read bar coded indicium to a paper path that leads to another bar code reader. Applicant respectfully disagrees with the Examiner's statement that Gilham discloses first, second and third bar code readers or first, second and third paper paths. The section of Gilham cited by the Examiner discloses nothing of the sort. Neither Gilham nor Pintsov deal with a more efficient or economical authentication of mail pieces without sacrificing accuracy. Therefore, claim 20 is not disclosed or suggested by the

combination of Gilham and Pintsov under 35 U.S.C. §103(a). Claims 21-23 depend from claim 20, and should be allowable at least in view of the dependencies.

In view of the foregoing, it is respectfully submitted that claims 1-23 are not unpatentable over Gilham in view of Pintsov under 35 U.S.C. §103(a). Each element of applicant's invention as claimed is not disclosed or suggested by Gilham or Pintsov either individually or in combination. Furthermore, there is no motivation to combine Gilham with Pintsov to achieve Applicant's invention. Even if the references were combinable in a fashion to achieve Applicant's invention, there must be a reasonable expectation of success. Neither Gilman nor Pintsov deal with a more efficient and economical authentication of mail pieces. Thus, a *prima facie* case of obviousness under 35 U.S.C. §103(a) has not been established and claims 1-23 should be allowable.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

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